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10/660,472

09/11/2003

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EXAMINER

THOMAS, ERIC M

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

12/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/660,472 | Applicant(s) SAITO ET AL. | |
| | Examiner Eric M. Thomas | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-11,13-15 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,9-11,13-15 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This is in response to the amendments filed on 9/9/10; claims 1, 11, 19, and 20 have been amended. Claims 1, 3 – 6, 9 – 11, 13 – 15, and 18 – 24 are pending in the current application.

Response to Amendment

This is in response to the amendments filed on 6/1/10; claims 1, 11, 19, and 20 have been amended. Claims 1, 3 – 6, 9 – 11, 13 – 15, and 18 – 24 are pending in the current application.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 – 6, 9 – 11, 13 – 15, and 18 – 20 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 8, 11, and 17 of copending Application No. 12/113637. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim a plurality of gaming machines wherein each of the gaming machines are capable of playing different types of games from each other, that comprises a first and second sending device for sending information, a point storage device, and a trading sending device for trading points that are stored in the point storage device.

This is a provisional obviousness-type double patenting rejection since the conflicting claims have not yet been patented.

Claim Rejections - 35 USC § 112

2. Claims 1, 11, 19, and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure is silent with respect to the points having a trading value unified through the games but not to be used in any one of the games directly. The limitation of trading value not to be used in any one of the games directly is considered to be new matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 3 – 6, 9 – 11, 13 – 15, and 18 – 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al. (U.S. 6,758,746) in view of Yen (U.S. 5,890,963).**

5. Regarding claims 1, 11, 19, and 20, Hunter discloses a game system comprising a plurality of game machines, (**“a plurality of game clients”, col. 7, line 22**), a game server that is in communication with said game machines, (**“a game server and a plurality of game clients”, col. 7, line 22**), wherein the points earned by players playing the game having a trading value unified through the games, (**“the points can**

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be exchanged for characters”, col. 7, lines 54 – 55), a first sending device for sending information including identification-information to identify a user and the points, **(“a player logon screen prompts the player to enter the player’s username and password”, col. 10, line 66 - col. 11, line 1)**, a point storage device for storing the points, an updating device for updating the points, and a trading device for trading the points stored in the point storage device for any one of plurality of unique data, **(“the points can be exchanged for characters”, col. 7, lines 54 – 55)**, but Hunter is silent on the issue of the gaming machines being capable of playing different kinds of games from each other and a converting device. In a related art, however, Yen discloses a system and method for game play in a computer network that includes at least one server and at least one gaming client, **(abstract)**, that is capable of playing different kinds of games from each other, **(“with respect to game play, variations include the continuous game play of substantially different games”, col. 12, lines 57 - 60)**, and a converting device for converting play-information indicating the contents of a user’s playing in each game on each of said game machines into points in accordance with the contents of the play-information, **(“each client (player) that plays the game acts a part time restaurant manager, and scores points during the period of game play”, col. 11, lines 1 – 5)**, wherein a player plays a role player type game and scores points based on the game play, (col. 11, lines 1 - 5), wherein any one of a plurality of unique data is used uniquely in any of the games, **(“characters from a Diner game may be used in a different game or gaming environment such as a mountain climbing game or running club game”, col. 12, lines 60 - 65)**, This is viewed by the examiner

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as game system being capable of allowing a player to use any one of plurality of unique data in any one of the games. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Yen into the art disclosed by Hunter in order to enable progressive and continuous game play in a game environment for enabling multiple players to enter multiple game environments, and for enabling players to maintain current knowledge and assets between game environments.

6. Regarding claims 3, 6, 13, and 14, Hunter discloses a data storage device for storing user available data that the identification-information and at least one of the plurality of unique data available to the user are associated with each other, (**"a plurality of databases that store information about games, game players, characters, and character attributes", col. 6, lines 50 - 52**), and a storage control device for when said server receives a trading request to trade anyone of the plurality of unique data, updating the points to a value obtained by subtracting points corresponding to the unique data to be traded and said trading device allows the unique data to be traded to be reflected in the user available data corresponding to the received identification-information, (**"the points can be exchanged for characters", col. 7, lines 54 – 55**).

7. Regarding claim 4, Hunter discloses storing authentication information for verifying the user in association with the identification-information and the points, (**"a player logon screen prompts the player to enter the player's username and password", col. 10, line 66 - col. 11, line 1**), wherein the trading and storage device

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updates the points ("**the points can be exchanged for characters**", col. 7, lines 54 – 55).

8. Regarding claim 5, Hunter discloses designating information each of which designates the plurality of unique data and the identification-information are sent in association with each other ("**a player logon screen prompts the player to enter the player's username and password**", col. 10, line 66 - col. 11, line 1), ("**the points can be exchanged for characters**", col. 7, lines 54 – 55).

9. Regarding claims 9 and 18, Hunter discloses that the identification-information is an individual identification-information to identify the user for each kind of the games, ("**a player logon screen prompts the player to enter the player's username and password**", col. 10, line 66 - col. 11, line 1), provides a game system that discloses a game server that is in communication with a plurality of game machines, (col. 7, lines 22 – 24), that includes a plurality of databases that store information about games, game players, and characters, (col. 6, lines 49 – 52), wherein the player is prompted to enter a username and password, which is required before the player to begin playing a game (col. 10, line 66 - col. 11, line 6). This is viewed by the examiner as the game system having a data storage device that stores the identification of the player wherein a server receives identification information corresponding to the player and linking the player to the game system

10. Regarding claim 10, Hunter discloses a readout device for reading individual identification-information from an information storage medium, ("**the character**

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database resides on a storage medium such as a CD-ROM or floppy disk", col. 7, lines 3 - 4).

11. Regarding claims 21 - 24, as stated above, Hunter discloses the points having a trading value, but is silent on the issue of including a converting device, however, this is overcome by the Yen reference as cited above.

Response to Arguments

12. Applicant's arguments filed on 9/9/10 have been fully considered but they are not persuasive. Regarding claims 1, 11, 19, and 20, Applicants argue that "Hunter does not teach the accumulation of points having a trading value unified through the games but not to be used in any one of the games directly, and therefore fails to cure the defects of Yen. In response to this, as noted above, the argued limitation is considered to be new matter. As disclosed in the disclosure of the present invention at par. 0009, the newly amended argued limitation is the opposite of what is disclosed, wherein it is stated that "the data may be music data or image directly used in the game." Therefore, the Examiner maintains that the cited art references render the present invention obvious.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M. Thomas whose telephone number is (571) 272-1699. The examiner can normally be reached on 7a.m. - 3p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lewis can be reached on (571) 272-7673. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric M. Thomas/
Examiner, Art Unit 3714

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/David L Lewis/

Supervisory Patent Examiner, Art Unit 3714